REMARKS

Claims 1-10 and 13-21 have been rejected under 35 USC §103(a) as obvious over Badesha, et al. in view of Swift, et al. In response, Applicants traverse the rejection.

Badesha, et al. teaches the following apparatus 1) a charge-retentive surface, 2) a development component, and 3) a fusing component. The reference does not teach or suggest an apparatus comprising the claimed elements including 1) a charge-retentive surface, 2) a development component, 3) a transfer component; 4) an intermediate transfer component, and 5) a transfix component. Applicants specifically point out that Badesha, et al. does not teach or suggest an image forming apparatus comprising a three-transfer member apparatus comprising all of 1) a transfer component, 2) an intermediate transfer component, and 3) a transfix component. These three claimed elements, in combination, are not taught or suggested by Badesha, et al.

Badesha, et al. teaches the claimed outer layer comprising a mica-type layered silicate and silicone elastomer, said silicone elastomer and said mica-type layered silicate together forming a delaminated nanocomposite. However, Badesha, et al. does not teach or suggest using the outer layer as an outer layer for a transfix component as claimed.

The Examiner relies on Swift, et al. as teaching a transfix component. However, Swift, et al. does not provide the deficiencies of Badesha, et al. Swift, et al. teaches an apparatus comprising 1) a charging station, 2) an imaging station, 3) a developer, 4) a transfer station having an intermediate transfer belt, and 4) a fuser or transfix component. Swift, et al., as with Badesha, et al., does not teach or suggest a three-transfer member apparatus comprising all of 1) a transfer component, 2) an intermediate transfer component, and 3) a transfix component.

Therefore, neither reference teaches or suggests the combination in the claimed apparatus of 1) a transfer component, 2) an intermediate transfer component, and 3) a transfix component.

In addition, neither reference teaches or suggests a heating member associated with a transfix substrate as claimed. Swift, et al. teaches a transfix component, but does not teach or suggest that a heating member is associated with the transfix substrate.

In addition, not only do the references not teach or suggest all of the elements of the claims, there is also no teaching or suggestion in the references to use the mica-type layered silicate material of Badesha, et. al. as an outer layer for a transfix component. Applicants submit that Swift, et al. teaches an apparatus that may include a fuser or a transfix component, but does not teach or suggest that a layer for a fuser member can be used successfully as a transfix component outer layer. Therefore, Applicants submit that the teaching in Swift, et al. at column 4, line 47, that an apparatus can include a "fuser or a transfix component," is not a teaching that an outer layer for use with a fuser component would work as a transfix component. The Swift, et al. reference does not teach or suggest that an outer layer useful as a fuser member can be successfully used as a transfix component. The reference merely states that an apparatus can have either a fuser member or a transfix component.

In view of the fact that neither reference teaches or suggests all the elements of the claims, including 1) a transfer component, 2) an intermediate transfer component, and 3) a transfix component, and further in view of the fact that there is no teaching or suggestion that an outer layer that can be used as a fuser member would be successful if used as an outer layer for a transfix member as claimed, Applicants submit that the present claims are not rendered obvious in view of the cited references. Accordingly, Applicants request withdrawal of the rejection of claims 1-10 and 13-21 under 35 USC §103(a) as obvious over Badesha, et al. in view of Swift, et al.

Claims 1-17 and 20-21 have been rejected under 35 U.S.C. §103(a) as obvious over Badesha et al. (U.S. 5,846,643, hereinafter, "Badesha et al. '643") in view of Badesha et al. (U.S. Patent 6,482,504, hereinafter, "Badesha et al. '504"). In response, Applicants traverse the rejection.

Badesha et al. '643 has been discussed above and does not teach or suggest the claimed apparatus including 1) a transfer component, 2) an intermediate transfer component, and 3) a transfix component. In addition, the reference does not teach or suggest a heating member associated with a transfix substrate.

Turning to Badesha et al. '504, this reference teaches an apparatus including 1) a transfer component, 2) an intermediate transfer component, and 3) a transfix component. However, the reference does not teach or suggest the mica-type layered silicate as claimed. Applicants submit that one of ordinary skill would not have been motivated to substitute the outer layer of the fuser member of Badesha, et al. '643 for the outer layer for the transfix member of Badesha, et al. '504.

There is no teaching or suggestion in either reference to modify the transfix component of Badesha, et al. '504 to include the mica-type layered silicate material taught by Badesha, et al. '643. Instead, the secondary reference teaches use of small molecules in the intermediate layer that diffuse through the outer layer and can be used as a release agent. Applicants submit that these teachings would not have motivated one of ordinary skill in the art to make the substitution of the outer layer as claimed. There is no mention of the claimed mica-type silicate outer layer in the secondary reference. Further, there is no mention in the reference implying that materials taught as useful as outer layers for fuser members, would work well as outer layers for transfix members. In addition, there is no teaching that small molecules as taught by Badesha, et al. '504 would likely have been substituted for the silicate as claimed and as taught by Badesha, et al. '643. In fact, the chemistry of the outer layer small molecules and release agent of Badesha, et al. '504 is completely different than the silicate taught by Badesha, et al. '643. One of ordinary skill would not have been motivated to substitute one for the other and expect the same or similar results. Absent some teaching or suggestion to make such a substitution, Applicants submit that the present claims are not rendered obvious in view of the cited combination. Accordingly, Applicants request withdrawal of the rejection of claims 1-17 and 20-21 under 35 U.S.C. §103(a) as obvious over Badesha et al. '643 in view of Badesha et al. '504.

Applicants respond to the Examiner's Response to Arguments as follows. Although Applicants begin the arguments with an analysis of the individual references, Applicants have provided arguments over the combination of references.

Applicants further point out that Swift, et al. does not teach the interchangeability of transfix and fuser members. Instead, Swift, et al. teaches that an apparatus may include either a fuser member or a transfix member. In addition, assuming *arguendo* that Swift, et al. taught the interchangeability of transfix and fuser members, this is not a teaching that an outer layer which can be useful as a fuser member, would work as a transfix member outer layer. This is also not a teaching or suggestion to make a substitution of outer layers for fuser and transfix members, or suggestion that such a substitution would be successful. Swift, et al. merely teaches that an apparatus can include a "fuser or a transfix component". This is not a teaching of interchangeability of the members, or that the outer layers should be the same.

Applicants respectfully disagree with the argument about product by process limitations. The facts are that neither Swift, et al. or Badesha, et al. '643 teach or suggest 1) a transfer component, 2) an intermediate transfer component, and 3) a transfix component. These are not product by process limitations; these are elements of an apparatus.

In addition the Examiner states that in order to have obviousness, there does not need to be a suggestion to modify the references. However, this is not the case. There must be some teaching or suggestion in the references that would have motivated one of ordinary skill in the art to make the combination and to make the change suggested in the obviousness rejection. Please see the following:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references

when combined) must suggest all th claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP §706.02(j). In addition, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987); *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). A piecemeal reconstruction of the prior art patents in light of Applicants' disclosure is not a basis for holding of obviousness, *In re Kamm, et al.*, 172 USPQ 298 (CCPA 1972). The mere fact that the prior art devices could have been modified does not make the modification obvious unless the prior art suggested the desirability of such a modification, *In re Gordon* 221 USPQ 1125 (Fed. Cir. 1984); Jones v. Hardy, 220 USPQ 1021 (Fed. Cir. 1984). (All underlining added by Applicants for emphasis)

Therefore, there must have been some teaching or suggestion to replace the transfix components of Swift, et al. or Badesha, et al. '504, with the outer fuser member layer of Badesha, et al. '643. There is no such suggestion or teaching. Also, there is no expectation of success that an outer layer for a fuser member would work as an outer layer of a transfix member. A transfix member transfers and fixes a developed image, whereas a fuser member only fuses the developed image. In addition, the combination if Swift, et al. and Badesha, et al. '643 does not teach or suggest all of the claimed elements.

Accordingly, Applicants submit the claims are not obvious in view of the combinations cited by the Examiner, including all of 1) a transfer member, 2) intermediate transfer member, and 3) transfix member.

In view of the above arguments, Applicants submit that all claims should now be in condition for allowance. Early indication of allowability is respectfully requested.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney (or agent) hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

In the event the Examiner considers personal contact advantageous to the disposition of this case, s/he is hereby authorized to call Applicant's Attorney, Annette L. Bade, at telephone number (310) 333-3682.

Respectfully submitted,

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September 29, 2003
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